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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,764	11/25/2003	Stephane Bedard	16616/76234	4189

26869 7590 01/24/2008  
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EXAMINER
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WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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01/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/721,764

Applicant(s)

BEDARD ET AL.

Examiner

Dave Willse

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-11,14-18 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-11,14-18 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on October 29, 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10-29-07; 1-8-08
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

In the Information Disclosure Statement of January 8, 2008, certain references were not considered because a concise explanation of the relevance (37 C.F.R. § 1.98(a)(3)) was not presented.

The Applicant has failed to particularly point out the support in the original disclosure for each of the newly presented revisions to the claims (MPEP §§ 714.02 and 2163.06) and must do so in response to the present Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5-11, 14-18, and 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 11, "an" should read --a--; on the last line of claim 1, "said pivotal axis" lacks a proper antecedent basis and is vague and indefinite as to which of the pivots is being referenced.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 5-11, 14-18, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, US 6,206,932 B1, which discloses a knee member **34** (Figure 2) or **602** (Figure 10); a socket connector assembly **26** or **604**; an elongated structural member connected to a prosthetic foot via a connector assembly (column 4, lines 3-12); a pivot assembly **50** or **606**; and a linear actuator **302** (Figure 5A; column 6, line 52 et seq.; column 9, lines 26-29) comprising a rotary member **310**, a screw **316**, and a follower **306** (column 7, lines 2-10). The motor **310** is pivotally connected to the structural member via a hinge connection **304b**, and the follower **306** is pivotally connected to the knee member via hinge connection **304a**. Regarding the functional “whereby” clause at the end of instant claim 1, attention is directed to MPEP § 2106; moreover, interchanging male and female portions of the threaded coupling such that rotated element **316** moves “in or out of said follower” (present claim 1, second to last line) would have been an obvious mechanical design variation yielding predictable results quite similar to those obtained from the illustrated embodiment (of Figure 5A). Regarding the preamble of claim 1, the aforementioned embodiments are functionally *capable* of being used with an above-knee amputation, whether or not such was the intent; additionally, the Johnson

mechanisms can be specifically adapted for above-knee amputees (column 4, lines 15-21), with the actuator and structural member being at least indirectly pivotally connected to a *prosthetic* knee member. The further limitations of claims 3, 5, 6, and 11 would have been obvious in order to shield the actuator **302** and other movable parts from the shell cover **22** (Figure 1) and the external environment, with the detachable closure having been obvious in order to access the actuator and other components for maintenance or replacement. Regarding claims 7 and 8, an energy storage module and circuit board supported on the shell would have been obvious in order to render the system more portable, self-contained, and manageable for a physically impaired amputee. Regarding claims 15-18 and 23-25, a controller and sensors were well known in the art and would have obvious for the switching system of Johnson because such elements would provide for fine-tuning the adjustments in the same manner as the wheel **322**, verifying the orientation of the foot via proprioceptors and the like, and modifying the orientation via load sensors or optical sensors, with the ordinary practitioner having been motivated by the innate need to store orientation data corresponding to the various footwear of the amputee (column 1, lines 58-61; column 2, lines 6-12 and 63-67; etc.) and “to change the loading on the knee socket in such a way that it provides less irritation to areas on or around the residual limb” (column 2, lines 60-63; column 1, lines 20-27).


The Applicant’s remarks have been considered but are deemed to be moot in view of the new grounds of rejection presented above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is 571-272-4762 and who is generally available Monday, Tuesday, and Thursday. If attempts to reach the examiner by

Application/Control Number:  
10/721,764  
Art Unit: 3738

Page 5

telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

  
**Dave Willse**  
**Primary Examiner**  
**Art Unit 3738**